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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,991	12/06/2001	Yuuji Saiki	020606	3509

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ARMSTRONG, WESTERMAN & HATTORI, LLP  
1725 K STREET, NW  
SUITE 1000  
WASHINGTON, DC 20006

EXAMINER

LAVARIAS, ARNEL C

ART UNIT PAPER NUMBER

2872

DATE MAILED: 04/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/015,991

Applicant(s)

SAIKI ET AL.

Examiner

Arnel C. Lavarias

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. The amendments to Claim 8 in Paper No. 5, dated 10/02/02, are acknowledged and accepted.
2. The addition of Claims 10-15 in Paper No. 5, dated 10/02/02, are acknowledged and accepted.

### *Specification*

3. The disclosure is objected to because of the following informalities:
  - ✓ It is uncertain whether the Applicants meant all instances of 'uttermost' to mean 'outermost'. See for example Page 5, line 13; Abstract page 25, line 4.
  - ✓ Page 3, line 16- delete 'has' after 'comprises'
  - ✓ Page 6, line 17- 'transeparent' should read 'transparent'
  - ✓ Page 13, line 24- 'is no particular limited, can used a suitable one.' is unclear.Appropriate correction is required.

### *Claim Objections*

4. ✓ Claims 5-8, 13-15 are objected to because of the following informalities:

Claim 5, line 2- it is unclear whether the Applicants meant 'uttermost' to mean 'outermost'. Claims 6-8, 13-15 are dependent on Claim 5, and hence inherit the deficiencies of Claim 5.

✓ Claims 13-15 recites the limitation "the protective film" in line 1 of each of Claims 13-

15. There is insufficient antecedent basis for this limitation in the claim. It is suggested that "the separator" be used instead.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Saiki et al. (JP2000-347010A or Saiki '010).

Saiki '010 discloses an optical member (See Figures 1-3) in which a surface of an optical material (See 2 in Figures 1-3) is bonded to and covered with a protective film (See 1 in Figures 1-3) having an outer surface roughness Ra of at least 0.03  $\mu\text{m}$  (See Abstract). Saiki '010 additionally discloses the protective film being disposed on one surface of the optical material (See 1 and 2 in Figures 1-3), a separator being provided on the other surface of the optical material via an adhesive layer (See 4 in Figures 1-3), the optical material comprising a polarizing plate and at least one of a retardation plate and a brightness enhancement plate (See for example 5 and 6 in Figures 2-3), and a liquid display having the optical member (See paragraph 0002).

7. Claims 5-8, 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Saiki et al. (JP2000-347181 or Saiki '181).

Saiki '181 discloses an optical member (See Figures 1-3) in which an adhesive layer (See 2, 21, 22 of Figures 1-3) disposed on an outermost surface of an optical material (See 3 in Figures 1-3) is provisionally bonded to and covered with a separator (See 1 in Figures 1-3) having an outer surface roughness Ra of at least 0.03  $\mu\text{m}$  (See Abstract). Saiki '181 additionally discloses the separator being disposed on one surface of the optical material (See 1 and 3 in Figures 1-3), a protective film being provided on the other surface of the optical material (See 4 in Figures 1-3), and the optical material comprising a polarizing plate and at least one of a retardation plate and a brightness enhancement plate (See for example 5 and 6 in Figures 2-3).

8. Claims 1-4, 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kobayashi et al. (JP2000-162438).

Kobayashi et al. discloses an optical member (See Figures 1-2, 4) in which a surface of an optical material (See 1, 13 in Figures 1-2, 4) is bonded to and covered with a protective film (See 1, 12, 14 in Figures 1-2, 4) having an outer surface roughness Ra of at least 0.03  $\mu\text{m}$  (See Abstract where the center line average roughness is 0.01-0.1  $\mu\text{m}$ ). Kobayashi et al. additionally discloses the protective film being disposed on one surface of the optical material (See 1, 12, 13, 14 in Figures 1-2, 4), a separator being provided on the other surface of the optical material via an adhesive layer (See paragraphs 0033-035), the optical material comprising a polarizing plate and at least one of a retardation plate

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and a brightness enhancement plate (See paragraph 0027), and a liquid display having the optical member (See Figure 4).

9. Claims 1, 3-4, 9-12 rejected under 35 U.S.C. 102(b) as being anticipated by Kameyama et al. (U.S. Patent No. 6088079).

Kameyama et al. discloses an optical member (See Figure 7) in which a surface of an optical material (See 3 or 61 in Figure 7) is bonded to and covered with a protective film (See col. 11, line 45-col. 12, line 4) having an outer surface roughness Ra of at least 0.03  $\mu\text{m}$  (See col. 11, line 45-col. 12, line 4). Kameyama et al. additionally discloses the protective film being disposed on one surface of the optical material (See col. 11, line 45-col. 12, line 4), the optical material comprising a polarizing plate and at least one of a retardation plate and a brightness enhancement plate (See Abstract), and a liquid display having the optical member (See Figure 7).

### *Claim Rejections - 35 USC § 103*

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kameyama et al.

Kameyama et al. discloses the invention as set forth above in Claim 1. Additionally, Kameyama et al. discloses the use of pressure sensitive adhesive layers on a separator

treated with a release agent for forming an optical element comprising superposed and united layers (See col. 15, lines 1-25). Kameyama et al. lacks the separator specifically being provided on the other surface (i.e. the surface on which the protective film is not on) of the optical material via an adhesive layer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the separator specifically be provided on the other surface (i.e. the surface on which the protective film is not on) of the optical material via an adhesive layer since the protective film is provided on the outermost surface of the optical member for surface protection, and the presence of an adhesive layer and a separator would prevent the protective film from performing its function in the optical member.

12. Claims 5-8, 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al.

Kobayashi et al discloses the invention as set forth above, except for the separator having an outer surface roughness Ra of at least 0.05 to 5  $\mu\text{m}$ . It would have been obvious to one having ordinary skill in the art at the time the invention was made to also have the separator have an outer surface roughness Ra of at least 0.05 to 5  $\mu\text{m}$  to prevent the separator portion of the optical member from sticking to adjacent optical members since such surface roughness treatments are similarly used to prevent the polarizing plate portion of the optical member from similarly sticking to adjacent optical members.

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*Conclusion*

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arnel C. Lavarias whose telephone number is 703-305-4007. The examiner can normally be reached on M-F 8:30 AM - 5 PM EST.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.



Arnel C. Lavarias  
April 10, 2003

